

REMARKS

Claims 1-17, 22-23, 25-29, 35, 37-40, 42-45 and 47-49 are pending in this application. Applicants have amended claims 1, 2 and 6 this response. Applicants refer to the Supplemental Response filed on March 18, 2003 in conjunction with this response. A copy of the March 18, 2003 response has been provided for the Examiner's convenience.

The Examiner has rejected all pending claims under 35 U.S.C. § 112, first paragraph because, according to the Examiner, the specification does not reasonably enable the Z moiety to represent the term OOH. As conveyed to Applicants' representative in a telephone conference, the Examiner believes that the existence of a oxygen-oxygen bond in the form of an OOH group makes the claimed compounds inherently unstable.

While the Examiner has rejected all pending claims, the objected-to term only appears in claims 1, 2 and 6. To further prosecution, Applicants have cancelled the OOH term in claims 1, 2 and 6. Applicants do not, however, acquiesce to the Examiner's determination that the specification does not enable the term "OOH" in the substituent list for the Z moiety. And Applicants certainly do not acquiesce to the Examiner's belief that an oxygen-oxygen bond would make the presently claimed chemical compounds unstable. Applicants point the Examiner to the plethora of chemical literature on peroxide groups and their utility in various chemical compounds, such as those used as commercial bleaching agents. As set forth in the supplemental response dated March 18, 2002 and discussed with the Examiner in multiple telephone conferences, the OOH embodiment of moiety Z is chemically and sterically feasible as originally recited.

In addition, removal of the term OOH from the listing of the options for moiety Z should not unduly limit the applicability of the claim, either in its literal inclusion or the scope of equivalents of moieties, particularly moieties other than moiety Z.

The Examiner has also objected to the claim phrase "hydrophobic, hydrophilic or fluorophilic" and the claim term "oxo" as being indefinite. Applicants refer to the Supplemental Response dated March 18, 2003 in addressing these objections. Before the March 18, 2003 response was filed, the amendments made in the response were discussed with and approved by the Examiner as satisfactorily overcoming these formatting objections.

As all objections on the record have been overcome through this response or the Supplemental Response dated March 18, 2003, Applicants respectfully request that the Examiner withdraw all outstanding rejections and timely allow this application.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned, "Version with markings to show changes made."

Except for issue fees payable under 37 C.F.R. §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. §1.136(a)(3).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP



Jeffrey N. Townes

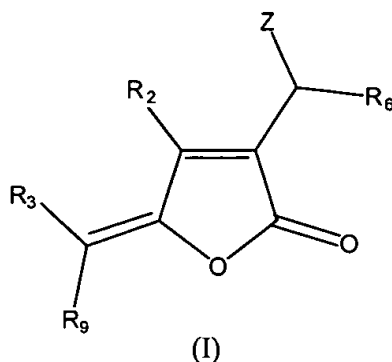
Reg. No. 47,142

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

1. A compound according to formula (I):



wherein R_6 is H, OH, alkyl, alkoxy, oxoalkyl, alkenyl, aryl or arylalkyl;

R_2 and R_3 are independently or both H or halogen;

R_9 is halogen;

Z is independently selected from R_6 , halogen, $[OOH,] OC(O)R_6, = O$, amine, azide, thiol, mercaptoalkyl, alkenyloxy, mercaptoalkenyl, aryloxy, mercaptoaryl, arylalkyloxy, mercaptoarylalkyl, $SC(O)R_6, OS(O)R_6, OS(O)_2R_6, NHC(O)R_6 = NR_4$ or NHR_4 ;

R_4 is OH, alkyl, alkoxy, poly(ethylene glycol), alkenyl, aryl or arylalkyl; and

wherein each constituent can be substituted or unsubstituted, straight chain or branched chain, and hydrophobic, hydrophilic or fluorophilic;

provided that:

when R_6 is propyl, R_2 is Br, R_3 is H or Br and R_9 is Br, then Z is other than H, $OC(O)CH_3$ or OH;

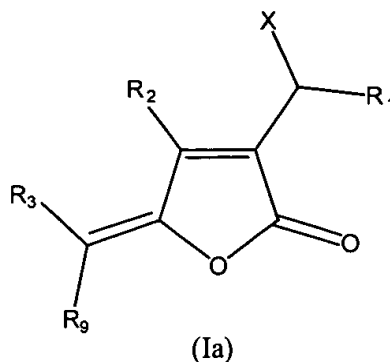
when R_6 is propyl, R_2 is Br, R_3 is H and R is I, then Z is other than $OC(O)CH_3$ or OH;

when R_6 is propyl, R_2 is Br, R_3 is H and R is Cl, then Z is other than OH;

when R_6 is propyl, R_2 is H, R_3 and R are Br, then Z is other than H; and

when R_6 is propyl, R_2 is Br, R_9 is Cl and Z is H, then R_3 is other than Cl.

2. A compound according to formula (Ia):



wherein R_1 is hydrogen, alkyl, alkoxy, oxoalkyl, alkenyl, aryl or arylalkyl;

X is a halogen, OH, [OOH,] OC(O) R_1 or =O;

R_2 and R_3 are independently or both hydrogen or halogen;

R_9 is halogen; and

wherein each constituent can be substituted or unsubstituted, straight chain or branched chain, and hydrophobic, hydrophilic or fluorophilic;

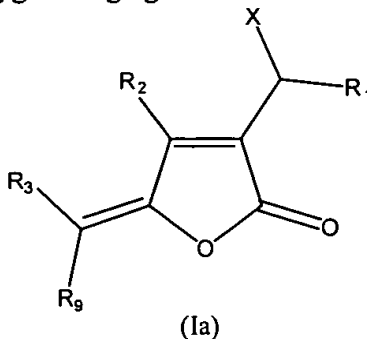
provided that:

when R_1 is propyl, R_2 is Br, R_3 is H or Br and R_9 is Br, then X is other than OC(O)CH₃ or OH;

when R_1 is propyl, R_2 is Br, R_3 is H and R_9 is I, then X is other than OC(O)CH₃ or OH; and

when R_1 is propyl, R_2 is Br, R_3 is H, R_9 is Cl, then X is other than OH.

6. A method for forming a compound of formula (Ia), comprising reacting a fimbrolide with a halogenating agent and/or an oxygenating agent to form the compound of formula (Ia):



wherein R_1 is hydrogen, alkyl, alkoxy, oxoalkyl, alkenyl, aryl or arylalkyl;

X is a halogen, OH, [OOH,] OC(O) R_1 or =O;

R_2 and R_3 are independently or both hydrogen or halogen;

R_9 is halogen; and

wherein each constituent can be substituted or unsubstituted, straight chain or branched chain, and hydrophobic, hydrophilic or fluorophilic.